

REMARKS

This responds to the Office Action mailed on January 31, 2007.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1, 3-5, 7-9, 11-13, and 15-16 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 3-5, 7-9, 11-13 and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morin (U.S. 6,748,422) in view of Coffman (U.S. Publication No. 2004/0215467). Applicants respectfully traverse this rejection for the reasons set forth below.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (*emphasis in original*).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicants respectfully submit that the Final Office Action did not make out a *prima facie* case of obviousness for the reason that the cited references fail to teach or suggest all of the elements of Applicants' claimed invention.

Claim 1 recites:

A network-based commerce system including:
a processor coupled to a memory through a bus; and
an auction price-setting process executed from the memory by the processor to cause the processor to receive a question associated with a listing for an item during the auction price-setting process, and to provide an answer to the question via a communications network, the providing of the answer including publishing the question and the answer on the listing for the item.

The Morin reference is unavailable as prior art and the Coffman reference fails to teach or suggest each recited claim limitation

1. Morin is excluded prior art under 35 U.S.C. § 103(c)(1).

Morin is subject to 35 U.S.C. § 103(c)(1). As a result, Morin is unavailable as prior art for purposes of a rejection under 35 U.S.C. § 103.

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. § 103(c)(1).

To qualify as prior art under 35 U.S.C. § 102(e)(2), a reference must be "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent" 35 U.S.C. § 102(e)(2). Morin claimed the benefit of a provisional application filed on October 19, 2000, and issued on June 8, 2004. (Morin, page 1). The instant application claims the benefit of a provisional application filed on December 31, 2002. (Specification, paragraph 0001). Hence, Morin qualifies as prior art under 35 U.S.C. § 102(e)(2). Morin, however, was assigned to eBay Inc. on December 3, 2001. Applicants were subject to an obligation of assignment to eBay Inc. on December 31, 2002. Thus, the subject matter of Morin and Applicants' claimed invention were owned by the same person or subject to an obligation of assignment to the same person, as of December 31, 2002. Therefore, Morin should be excluded

as prior art under 35 U.S.C. § 103(c)(1) and cannot be combined with Coffman to render the present claims obvious under 35 U.S.C. § 103(a).

2. *Coffman alone does not teach or suggest all claim elements.*

The single reference of Coffman does not anticipate the present claims or render the present claims obvious. The Final Office Action asserts that, "Coffman discloses a network-based commerce system wherein the fixed price-setting process further causes the processor, when providing the answer to publish the question and the answer *on the listing for the item*. (Coffman: paragraph 0136)." (Final Office Action, page 4, paragraph 1, emphasis added). Applicants respectfully disagree. With respect to questions and answers, Coffman discusses a "Web page screen" containing "RFQ generation options," a "Q&A Log" (described as a "window or log of questions and answers"), and a "questions and answers web page," none of which are used to, "...to receive *a question associated with a listing for an item during the auction price-setting process*, and to provide an answer to the question via a communications network, the providing of the answer including *publishing the question and the answer on the listing for the item*," as recited in claim 1. (Emphasis added).

In the paragraph cited by the Examiner, Coffman describes, "[a] Display Q&A Log link 1440 [that] allows the author to click on the link to display a window or log of questions and answers posted at the auction Web site." (Coffman, paragraph 0136). This link (Coffman, reference 1440) is part of, "a Web page screen displaying additional RFQ *generation options*." (Coffman, Fig. 14, and paragraph 0028, emphasis added). Coffman expressly states this Web page screen (Coffman, reference 1400) "includes additional features *for the author*." (Coffman, paragraph 0131, emphasis added). Coffman describes several authoring tools on this Web page screen, including *inter alia*:

- a "Create New Author" field, (Coffman, reference 1402 and paragraph 0127);
- a "Create New Buyer" field, (Coffman, reference 1412 and paragraph 0128);
- a "Create New Technical Review Team Member" field, (Coffman, reference 1420 and paragraph 0128);
- a "Password Protect?" link, (Coffman, reference 1422 and paragraph 1422);

an option to "Open [the auction] to Unqualified Suppliers," (Coffman, reference 1426 and paragraph 0131);

a "Postpone Auction Until" field, (Coffman, reference 1434 and paragraph 0134);

an "Edit/Amend RFQ" link, (Coffman, reference 1438 and paragraph 0135);

a "Cancel RFQ" link, (Coffman, reference 1436 and paragraph 0134); and

a "Submit RFQ" button, (Coffman, reference 1430 and paragraph 0148).

Accordingly, the Web page screen described in Coffman enables an author to alter the parameters of an auction or cancel an auction outright. (Coffman, Fig. 14 and paragraphs 0126 - 0155). Nothing on the Web page screen of Coffman lists an item. Therefore, clicking the "Display Q&A Log" link of Coffman does not disclose, "...to receive a question associated with a listing for an item during the auction price-setting process, and to provide an answer to the question via a communications network, the providing of the answer including publishing the question and the answer on the listing for the item," as recited in claim 1.

Moreover, at the very least, the "window or log of questions and answers" of Coffman (paragraph 0136) is not a listing for an item. This window or log is displayed to an author upon clicking a "Display Q&A Log" link. (Coffman, reference 1440 and paragraph 0136). Hence, the "window or log of questions and answers" of Coffman is the "Q&A Log" of Coffman. Coffman describes this "Q&A Log" as including at least four fields: "question number," "question," "response," and "response author." (Coffman, paragraphs 0136 - 0140). The "Q&A Log" of Coffman may permit cutting and pasting of text, and may include a "Submit" button. (Coffman, paragraph 0141). There is no suggestion in Coffman that this "Q&A Log" lists an item. Consequently, the questions and answers that appear in the "Q&A Log" of Coffman do not disclose, "...to receive a question associated with a listing for an item during the auction price-setting process, and to provide an answer to the question via a communications network, the providing of the answer including publishing the question and the answer on the listing for the item," as recited in claim 1.

Furthermore, Coffman discloses that the questions and answers of the "Q&A Log" are "posted at the auction Web site" (Coffman, paragraph 0136). These questions and answers exist on a "question and answer web page" (Coffman, claim 2). A "question and answer web page" is clearly a separate and distinct web page for questions and answers. Applicants are unable to find

any discussion in Coffman suggesting that questions and answers appear *on a listing for an item*. Thus, the questions and answers of Coffman do not disclose, "...to receive *a question associated with a listing for an item during the auction price-setting process*, and to provide an answer to the question via a communications network, the providing of the answer including *publishing the question and the answer on the listing for the item*," as recited in claim 1.

Therefore, for at least these reasons, claim 1 and all claims dependent therefrom are patentable over the single reference of Coffman. The same arguments that applied to claim 1 are also applicable to independent claims 5, 9 and 13 and their associated dependent claims. Therefore it is respectfully requested the rejections of these claims be removed and the claims be placed in condition for allowance.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4045 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/749,431

Filing Date: December 30, 2003

Title: SELLER-CONTROLLED PUBLICATION OF QUESTION AND ANSWER SETS

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Dkt: 2043.101US1



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26 day of March 2007.

Peter P. Reber

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